

Appl. No. 10/054,113
Atty. Docket No. 8364M
Office Action dated: 16 June 2005
Reply Dated: 16 September 2005
Customer No. 27752

AMENDMENTS TO THE DRAWINGS

The attached replacement sheets of drawings include changes to Fig 2, and Fig. 3. These sheets, which include Fig. 2, and Fig. 3, replace original sheets 2 and 3 and therefore, Fig. 2 and Fig. 3. In Figure 2, the feature “interior surface,” identified as 48, is replaced with 49, and the reference number is repositioned. Further, to provide clarity to the drawings, the reference numbers identifying features 28 and 36 are repositioned. The arrows and lines connecting the features identified as 40, 41, 46, 45, 48, 47, 42, and 44, with their respective reference numbers, previously shown with solid lines are replaced with broken lines in Fig. 2.

In Fig. 3 the feature identified with reference number 144, shown previously as 144, is now shown with an arrow and a connecting line and the reference number is repositioned.

Applicants submit that these changes are consistent with and supported by the specification. No new matter is added.

Attachment: Formal Replacement Drawing Sheets 2 and 3

REMARKS

Claims 4-23 are pending in the application, with Claims 4-23 standing presently rejected. Herein, Applicants amend claims 4, 7, 8, and 12, cancel claims 6 and 22, and add new claim 24, whereupon claims 4, 5, 7-21, and 23-24 remain to be examined.

Claim 4, in the first subsection (a), is amended to replace the term “graspable means” with “tab extending outwardly therefrom” to more particularly point out and distinctly claim the invention. Support for the amendment is found, at least, at page 3, lines 29-30 of the specification.

Claim 4, in the first subsection (c), is also amended to replace the term “graspable means” with “tab extending outwardly therefrom that is offset laterally from the applicator substrate tab” to more particularly point out and distinctly claim the invention. Support for the amendment is found, at least, at page 5, line 19-20 and page 5, lines 3-4 of the specification.

Claim 4, in the second subsections (a) and (b), is also amended to replace the term “graspable means” with “tab” to more particularly point out and distinctly claim the invention. Support for the amendment is found, at least, at page 3, lines 29-30 of the specification.

Claim 4 is also amended to replace the term “having” with “comprising” to more particularly point out and distinctly claim the invention. Support for the amendment is found, at least, at page 7, lines 22-23 of the specification.

Claim 4 is also amended to add the terms “of the patch” to more particularly point out and distinctly claim the invention. Support for the amendment is found, at least, at page 6, lines 16-17 of the specification.

Claim 7 is amended to add the terms “or both are” to more particularly point out and distinctly claim the invention. Support for the amendment is found, at least, at page 8, lines 9-12 of the specification.

Claim 8 has been amended to more particularly point out and distinctly claim the invention. Claim 8 is amended to add the terms “an area.” Support for the amendment is found, at least, in claim 8.

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Applicants have added a new claim 24. Support for the amendment is found, at least at page 7, lines 19-21.

Claims 6, and 22, are canceled without prejudice.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

FORMAL MATTERS

DRAWINGS

The attached replacement sheets of drawings include changes to Fig 2, and Fig. 3. These sheets, which include Fig. 2, and Fig. 3, replaces original sheets 2 and 3 and therefore, Fig. 2 and Fig. 3. In Figure 2, feature "interior surface" identified as 48 is replaced with 49 and the reference number is repositioned. Further, to provide clarity to the drawings, the reference number identifying the features 28 and 36 are repositioned. The arrows and lines connecting the features identified as 40, 41, 46, 45, 48, 47, 42, and 44, with their respective reference numbers, previously shown with solid lines are replaced with broken lines in Fig. 2.

In Fig. 3 the feature identified with reference number 144, shown previously as 144, is now shown with an arrow and a connecting line and the reference number is repositioned.

Applicants submit that these changes are consistent with and supported by the specification. No new matter is added.

CLAIMS

The Office Action is correct in stating that claim 4 was rejected in the First Office Action dated 10 October 2003. However, Applicants attorney, in his reply of 01 March 2004, was merely pointing out that claim 4 was not rejected under 35 USC §102 for the lack of novelty.

Claim 8 is objected to as having an allegedly extrafluous word, i.e., "comprises." Without commenting on the validity of the allegation and merely to expedite prosecution,

Applicants have amended claim 8 by adding the terms “an area” that improves the readability of the claim. Applicants submit that amended claim 8 is free of extrafluous words.

Rejection Under 35 USC §103(a) Over US Patent No. 6,124,522 in view of US Patent No. 5,772,623

Claims 4-12, and 18-21 are rejected under 35 USC §103(a) as allegedly being unpatentable over Schroeder, US Patent No. 6,124,522 (hereinafter Schroeder), in view of Conte, US Patent No. 5,772,623 (hereinafter Conte).

The Office Action first characterizes the invention of Schroeder and concludes that Schroeder however does not teach a non-securing edge. The Office Action then alleges that Conte teaches a bandage with a non-securing edge, thereby rendering Applicants' invention obvious.

Applicants submit that the Office Action mischaracterizes Schroeder when applying it to Applicants' invention. It is Applicants' discovery that the pattern of the adhesive area 40, more specifically the adhesive contact area, is a significant factor in determining the strength of the first peel bond. The presence of the “circumferential lateral edge” 45, with its leading edge 46, trailing edge 47, and non-securing edge 48, governs how the patch 44 is applied to a target surface without curling up or without the need for the user to touch the patch. Schroeder on the other hand, teaches applying adhesive to entire surfaces. For example, Fig. 2, and the description at column 4, lines 32-34, discloses that adhesive layer 3 is applied to the backing sheet 1. Schroeder does not disclose the concept of a circumferential lateral edge, let alone a non-securing edge.

The Office Action also alleges that Applicants are not specific about the location of the leading and trailing edges in the claims, and thus, Schroeder's patch allegedly meets the Applicants' general limitations. Applicants respectfully disagree and point to the second subsections (a), (b), and (c) of claim 4 which define the leading edge, the trailing edge, and the non-securing edge, respectively. Applicants provide guidance in the specification at page 6, lines 3-4, that “the circumferential lateral edge” means the lateral edge of the outer most surrounding boundary of the patch 44. It is with respect to the patch that these locations are defined. Further, in the specification at page 6, lines 16 to page 7, line 6, Applicants explain the terminology and the significance of these

features. Therefore, Applicants submit that claim 4 is specific about the location of the leading edge, the trailing edge, and the non-securing edge.

Applicants respectfully submit that the Office has failed to make a *prima facie* case for the obviousness rejections. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or combine the references' teachings. See *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); MPEP §2143.01. Second, there must be reasonable expectation of success. See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP §2143.02. Third, the prior art reference or the combined references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP §2143.03. Furthermore, in establishing a *prima facie* case of obviousness, case law clearly places the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103". *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967).

Schroeder is concerned with addressing problems hindering the ease and effectiveness of applying package-enclosed adhesive [patches] (e.g. col. 2, lines 48-63). Conte, on the other hand, teaches a bandage having a tab portion for the easy removal of the bandage from the skin. Conte is concerned with solving the problem of repeated removal of strong surgical bandages that hurt, cut, and may warrant stitches (column 1, lines 27-38). Conte allegedly achieves this by having an adhesive tab on the upper untreated bandage surface which could be then pulled up by a finger tip or finger nail and the entire bandage could be removed (column 3, lines 8-10). Thus, Schroeder is concerned with applying the bandage while Conte is concerned with the removal of a bandage. Thus, a skilled person would not be motivated to combine the teachings of Schroeder with Conte. Further, even if a skilled person were to combine the teachings of Schroeder and Conte, all the elements of the presently amended claim 4 would not be present. Neither Schroeder nor Conte teach or suggest a circumferential lateral edge comprising of a leading edge, a trailing edge, and a non-securing edge or tabs that are offset laterally. Further, Conte's bandage is made of only two components, namely, the dressing and the cotton pad. On the other hand, the applicator of amended claim 4 comprises of three separate components with tabs that are offset laterally and wherein the patch comprises of a leading edge, trailing edge, and a non-securing edge.

Moreover, “[w]hen applying 35 USC §103, the following tenets of patent law must be adhered to: (1) The claimed invention must be considered as a whole; (2) the reference must be considered as a whole and must suggest the desirability and thus the obviousness of making the contribution; (3) the reference must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (4) reasonable expectation of success is the standard with which obviousness is determined”. (Emphasis added) *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1145 n.5, (Fed. Cir 1986), MPEP 2141.02. In short, under the “invention as a whole” test for 35 USC §103, the Office must take into consideration the presence of laterally offset tabs and the circumferential lateral edge comprising of a leading edge, a trailing edge, and a non-securing edge – factors that are not taught or suggested by either Schroeder or Conte. Therefore, Applicants submit that Schroeder in view of Conte does not render any of claims 4, 6, 8, and 11 obvious.

Based on the above discussion, Applicants submit that Office has failed to make a *prima facie* case for the obviousness rejections, and the rejection should be withdrawn.

Rejections Under 35 USC §103(a) Over US Patent No. 6,124,522 in view of US Patent No. 5,772,623, and further in view of Applicants Disclosure, and in view of US Patent No. 6,043,406

Claims 5, 7, 9-10, and 18-21 are rejected under 35 USC §103(a) as allegedly being unpatentable over Schroeder in view of Conte. Claims 13-15 are rejected under 35 USC §103(a) as allegedly being unpatentable over Schroeder in view of Conte and in view of “Applicants own admission.” Claims 16, 17, and 23 are rejected under 35 USC §103(a) as allegedly being unpatentable over Schroeder in view of Conte and in view of Sessions (U.S. Patent No. 6,043,406). Applicants respectfully traverse the rejections for the reasons set forth herein.

Claims 5, 7, 9-10, 13-21, and 23 are rejected based upon Examiner’s contention that Schroeder and Conte teach the claimed invention. Applicants’ submit that in view of the above arguments, they have proven that a *prima facie* case of obviousness has yet to be made, and as such, Applicants’ submit that the Office’s rejections of claims 5, 7, 9-10, 13-21, and 23, must establish a *prima facie* case of obviousness of the invention including all of the limitations of amended claim 4, from which aforementioned claims all depend either directly or indirectly. As such, Applicants submit that Conte, Sessions, or Applicants’ “own admission,” does not remedy the failure of Schroeder (argued above

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and renewed here) to teach or suggest all of claim limitations of Applicants' invention, nor does it provide motivation to combine Schroeder with any one or more of the cited references to arrive at Applicants' invention, at least because each of the references fail to teach the presence of tabs that are offset laterally and the circumferential lateral edge comprising of a leading edge, a trailing edge, and a non-securing edge, alone or in combination with Schroeder. As such, Applicants submit that the rejections are improper and should be withdrawn.

CONCLUSION

In light of the above remarks, it is requested that the Examiner enter the amendments presented, reconsider and withdraw the pending rejections, and allow the pending claims. Early and favorable action in the case is respectfully requested.

Respectfully Submitted,

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